

Remarks

Assignee thanks the examiner and his SPE for the indicated allowance of most of the claims pending and the thoughtful remarks concerning claims 53 and 54, which were rejected. Assignee's representative also thanks the examiner for the interview, which helped clarify the examiner's concerns underlying the Section 101 rejection. The interview report does not accurately express the content and tone of the discussion with the SPE during the interview, but it is not considered necessary to discuss that issue.

Applicant's attorney has carefully reviewed the examiner's remarks, canceled claims 53 and 54, and now presents independent claim 57, and associated dependent claim 58, that is believed to meet the requirements of the statute (35 U.S.C. §101) and that contains the same distinctions over the cited prior art that the Office has now accepted for all other claims of this application.

Again, applicant and the undersigned wish to avoid disputing unsettled or unclear issues as to claims related to "signals," transitory states, transmission media, etc. Applicant respectfully requests careful review, in view of the below remarks, of the newly written claim, with a fresh eye. The following points are believed sufficient to convince the Office that this claim falls well within the bounds of Section 101:

1. Claim 57 is directed to "An apparatus comprising: (1) a first computer coupled through the Internet computer network to a multitude of second computers; and (2) a data stream in the memory of the first computer" An apparatus is a machine, and a computer is a machine. That fact alone suffices to satisfy Section 101.

In response to a similar argument made before, the Office Action (p. 4) stated as follows: *"Examiner submits that in light of the Specification and as detailed above, the 'Internet computer' in this case clearly serves as merely a 'transmission media', which is intended to include wireless mediums (see Specification paragraph [0047])."* Putting aside whether that comment was true before, it is not correct with respect to claim 57 proposed now. The claimed invention is to a configured computer. That is stated in the body of the claim itself. The claimed computer, per the claim, must be coupled to other computers, and that may be done by wire, or wirelessly, or both. All that is claimed, however, is a computer and data, in the computer's state of being coupled to other

computers. The claim does not include the *couplings*, nor does the claim include any “transmission media.” The Office may not recharacterize any claim in order to reject it. The fact that a tangible computer (machine) has function as part of a larger transmission path that may elsewhere include wireless couplings is irrelevant to patentability.

2. Claim 57 is closely analogous to *Beauregard* claims, which the Office clearly recognizes as statutory. A *Beauregard* claim consists of “indicia of instructions” residing on a “data storage medium.” Proposed claim 57, likewise, refers to a “data stream” residing “in the memory of a first computer” – a computer memory is a specific type of data storage medium. The proposed claim equally should be patentable.

Dependent claim 58 emphasizes the closeness of the relationship of the proposed claims to *Beauregard* claims. Claim 58 specifies that some of the data in the “data stream” of claim 57 (in the “second frame”) can be “data computer-readable as a computer program implementing a direct file access module.” Thus, dependent claim 58 is a *Beauregard* claim.

3. Claim 57 defines an invention that has practical application, produces useful, concrete, and tangible results, and is useful and functional. The Office Action states (p. 4) that the “*claimed data/elements ... do not impart any functionality whatsoever on any implied destination computer or the like, but instead is clearly directed to ‘identifying’ a particular computer (but itself does not cause a computer to perform the identification) or data representing a body of an e-mail.*”

Claim 57 has been written to clarify explicitly the functionality that the claimed data/elements impart to the destination computer. Although the examiner is correct that the body of the email is descriptive matter, the same is not true for the remainder of the data, as now explicitly clarified by the claim body. The statement, which forms the cornerstone of the rejection, that the claimed data/elements “do not impart any functionality whatsoever on any implied destination computer” is, respectfully, squarely incorrect.

4. In sum, applicant’s representative has written a claim (1) that is expressly directed to a machine with stored data and (2) that has expressly stated functionality when the data stored in the machine is applied to a computer. Allowance of such a

claim requires no greater stretch than allowance of a *Beauregard* claim. Prompt allowance is respectfully requested.

If the examiner has any questions, please feel free to contact assignee's undersigned attorney.

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by its attorney

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